

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1-15 will have been canceled and claims 16-26 will have been newly submitted for consideration by the Examiner.

In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, for the acceptance of the drawings filed in the present application on April 11, 2001, and for the acknowledgment of Applicant's claim for priority under 35 U.S.C. § 119 and receipt of the certified copy of the priority document in the Official Action. Applicant further notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on June 22, 2001 and June 28, 2002 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

Turning to the merits of the action, the Examiner has rejected claims 1, 5-8, 10-11, and 13-15 under 35 U.S.C § 102(e) as being anticipated by TOYODA_1998 (U.S. Patent No. 6,094, 277). The Examiner has also rejected claims 2-4, 9, and 12 under 35 U.S.C § 103 as being unpatentable over TOYODA_1998 in view of TOYODA_1999 (U.S. Patent 6,778,287).

As noted above, Applicant has canceled the rejected claims 1-15 and has submitted new claims 16-26. Applicant respectfully traverses the above rejections based on newly submitted claims 16-26 and will discuss said rejection with respect to

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the pending claims in the present application as will be set forth hereinbelow. The newly added claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 16-22 generally relate to an electronic mail communication apparatus which transmits an e-mail to a destination via a mail server. The electronic mail communication apparatus comprises a scanner configured to scan image data and a memory configured to store a limit capacity of the mail server. The limit capacity indicates a maximum data amount that the mail server can store for one e-mail transmission. The electronic mail communication apparatus comprises a controller which converts the image data into data for Internet transmission, attaches the converted data to the e-mail, and transmits, to the destination, the e-mail to which the converted data is attached, via the mail server. Further, the controller compares the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server. Claims 23-26 recite a related method.

Regarding the rejection under 35 U.S.C. § 102(e) asserted by the Examiner, TOYADA_1998 relates to an Internet facsimile apparatus on the receiving side (column 4, lines 6-16). The Internet facsimile apparatus of TOYADA_1998 checks whether a mail server receives a new e-mail, downloads e-mail data from the mail server, and stores the e-mail data in data area 28. The data area 28 has a capacity of 1 MB. The Internet facsimile apparatus decides whether one page is 1 MB or less. When the one page exceeds the capacity of data area 28, 1 MB, the Internet facsimile apparatus transmits, to the sender, an error message to which "Message ID" is attached (column 5, lines 37-44).

However, although data area 28 of TOYADA_1998 has the capacity of 1 MB, data area 28 is a component of Internet facsimile apparatus but not a component of or of a part of the mail server (Fig. 2).

On the other hand, the present invention relates to an Internet electronic mail communication apparatus on the transmitting side. The Internet electronic mail communication apparatus transmits image data to a destination via a mail server, as cited in pending claims. The Internet electronic mail communication also stores a capacity of the mail server. The capacity of the present invention means the capacity of the mail server, but does not indicate the capacity of the Internet electronic mail communication apparatus itself.

Thus, TOYODA_1998 does not disclose a memory which stores the capacity of the mail server. TOYODA_1998 also does not disclose a controller which determines whether an amount of the image data to be transmitted exceeds the capacity of the mail server. In this regard, the present invention is clearly distinguished over TOYODA_1998.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 16-26 are not disclosed in TOYODA_1998 cited by the Examiner.

Regarding the rejection under 35 U.S.C. § 103(a) by the Examiner, TOYODA_1999 relates to a communication apparatus which transmits a confirmation e-mail to the sender when image data which is attached to a receiving e-mail is printed out by a printer of the communication apparatus. However, TOYODA_1999 discloses neither a memory which stores the capacity of the mail server nor a controller which determines whether an amount of the image data to be transmitted exceeds the

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capacity of the mail server. Thus, the present invention is clearly distinguished over TOYODA_1999.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 16-26 are not disclosed in TOYADA_1999 cited by the Examiner. Pending claims are submitted to also be patentable over the Examiner's proposed combination, since neither of TOYODA_1998 and TOYADA_1999 discloses the combination of features recited in Applicant's claims 1-26.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection and an indication of the allowability of all the claims pending in the present application in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has canceled the rejected claims and has submitted new claims for consideration by the Examiner. With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the new claims with the disclosures of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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